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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 02410335AA	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]		Application Number 10/620,703	Filed 07/17/2003
on _____		First Named Inventor Y. Sakoh	
Signature _____		Art Unit 3714	Examiner R. Renwick
Typed or printed name _____			
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/>	applicant/inventor.	Signature	
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/95)	_____ Michael E. Whitham Typed or printed name	
<input checked="" type="checkbox"/>	attorney or agent of record. Registration number 32,635	_____ (703) 787-9400 Telephone number	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	_____ December 15, 2008 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Yoshitaka Sakoh

Serial No. 10/620,703

Filed July 17, 2003

For CONTROLLER

Confirmation No. 9315

Group Art Unit 3714

Examiner Reginald A. Renwick

Mail Stop AF

Commissioner for Patents

PO Box 1450

Alexandria, Virginia 22313-1450

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

This Pre-Appeal Brief Request for Review is being concurrently filed with a Notice of Appeal. Please charge the fees for the Notice of Appeal to Attorney's Deposit Account 50-2041 (Whitham, Curtis, Christofferson & Cook, P.C.). If any additional fees are required to satisfy the fees due for the Notice of Appeal or to gain entry and consideration of this Pre-Appeal Brief Request for Review, the Commissioner is authorized to charge Attorney's Deposit Account 50-2041 (Whitham, Curtis, Christofferson & Cook, P.C.).

The Invention

The invention solves a specific problem in a specific type of game controller. More particularly, the disclosed and claimed invention eliminates the possibility of damage to the printed circuit board due to the replacement of batteries and operation of push switches. As shown in Figure 1, the main board 1 is provided with a parts holder 2 having a central, table portion 4. Figures 2B and 2C show that the parts holder 2 is attached to the main board 1 by means of positioning pins 21 inserted into holes in the main board and engaging hooks 22, which engage square holes in the main board. Figures 2B and 2C also show that the table portion 4 is elevated above the surface of the main board. Battery terminal holder portions 24, 25 are surrounded by an integrally formed rib 23 formed on the left and right sides of the table portion

4. When the battery terminal board (not shown) is set to the battery terminal holder portions 24, 25, lower end portions of the battery terminal board are projected downward via holes 26 in the bottom plate, as shown in Figure 3B. Push switches 11 provided on the push switch boards 10 are operated by push keys 3. The switch boards 10 are supported by board holder portions 9 which project vertically above the parts holder 2. These holder portions 9 are provided with ribs 29 on the back surface and ribs on the front surface.

Since the battery terminal board is held by the parts holder 2, the back-and-forth movement of the battery terminal board is suppressed by the rib 23 that surrounds the periphery of the battery terminal board. The ribs of the board holder portions 9 withstand the pressure applied by the push keys. In this way, the parts holder 2 isolates the main board 1 from the bending and torsional stresses relating to battery replacement and operation of the push keys, thereby preventing cracking of printed-circuit patterns or damage to soldered portions of the battery contact board.

Errors and Omissions

As to claims 1 and 6, the Examiner has failed to make out a *prima facie* case of obviousness under 35 U.S.C. §103 based on U.S. Patent No. 5,207,426 to Inoue et al. in view of U.S. Patent No. 5,268,542 to Voll, and as to claims 5 and 7, the Examiner has failed to make out a *prima facie* case of obviousness under 35 U.S.C. §103 based on the patents to Inoue et al. and Voll in view of U.S. Patent No. 5,670,988 to Tickle. As to claims 8, 9, 10, 11, 12, and 13, the Examiner has not provided a statement of the Statutory ground of rejection or the references relied upon for the rejection. For purposes of this response, it is assumed that these claims are rejected under 35 U.S.C. §103(a) as being unpatentable over the patents to Inoue, Voll and Tickle, as in the rejection of claims 5 and 7.

The parts holding member recited in claim 1 receives a stress generated when the push switch which is mounted on the switch board which extends perpendicular to the main board is pushed. As acknowledged by the Examiner, Inoue et al. does not disclose such a member. Rather, Inoue et al. discloses a switch board 146 which extends perpendicular to the main board 16 and is inserted to notches formed near left and right corners of the board 16 (see, column 5, lines 45–47). On the other hand, the Examiner asserts that Voll discloses the claimed parts holding

member. This is in error. Although Voll discloses the spacer 14 interposed between the circuit boards 8 and 15, there are no circuit boards which extend perpendicular to one another. Therefore, the structure and the function of the spacer 14 in Voll are completely different from the structure and function of the parts holding member in the present invention.

Inoue et al. discloses a game controller of an entirely different structure and configuration of the game controller claimed. The Examiner seems to recognize this when he states that "Inoue fails to disclose that the parts holding member is interposed between the switch board and the main board and adapted to receive a stress generated when the push switch is pushed" and when he states that "Inoue fails to disclose a battery for the game controller." The Examiner makes reference to a "parts holding member" in his description of Inoue et al., and in his "Response to Arguments", he has identified such a member as "objects 111 and 112 in Fig. 5". These "objects" are identified as the "upper half" and "lower half", respectively, of the housing 11 (see col. 4, lines 5 and 6. This structure clearly is not the equivalent to the claimed "a parts holding member, interposed between the switch board and the main board and adapted to receive a stress generated when the push switch is pushed" (see claim 1).

The bottom line is that the only thing that Inoue et al. has in common with the specifically disclosed and claimed invention is that Inoue et al. disclose a "game controller". But the Inoue et al. game controller is of entirely different construction and fails to provide the isolation of the stresses induced by operation of the push switches and replacement of batteries. It is the parts holding member 2, illustrated in Figures 2A to 2C and 3A and 3B which is the key to the disclosed and claimed invention, and there is simply no equivalent to the parts holding member in Inoue et al. or, as will be shown, Voll or Tickle.

The Examiner relies on Voll for a teaching of "a parts holding member for a push button that contains a space portion (object 14 of Fig. 1) that separates the switch board from the main board." What Voll discloses is a multi-step switch including a resiliently mounted push button 3. In a first stage of the pressed-in state, the push button presses a contact surface 5a against a partially resiliently constructed printed circuit board 8 which, on the upper side thereof, is provided with conductors. In a second stage of the pressed-in state of the switch, the push button and, in turn, the printed circuit board press with the aid of the resilient push element 21 against additional conductors arranged on a circuit board 15 underneath the printed circuit board 8. The spacer element 14 separates the circuit boards 8 and 15.

The structure disclosed by Voll has no equivalency with the claimed “parts holding member”. There is no isolation of the stresses applied to a push switch and a main circuit board. On the contrary, there is a direct mechanical interaction between Voll’s push button 3 and the lower circuit board 15 via the resilient circuit board 8 and the resilient push member 21. Further, the claimed invention requires that the switch board extend perpendicular to the main board, and this is not shown in any reference of record.

The Examiner cites the patent to Tickle for a teaching of a “controller [which] comprises a battery terminal holding member, holding a battery terminal and integrally and monolithically formed with the parts holding member (Abstract; Fig.3)”. What Tickle discloses is a battery powered infrared transmitting device for controlling the operation of a computer. There is no “parts holding member” mounted on a main board. Moreover, the Tickle device and the Voll device have no similarity in structure or function to the Inoue et al. game controller, and there is no reasonable combination of these three, unrelated references that would conceivably result in Applicant’s specifically claimed invention.

As to claims 8 to 11, the Examiner notes that “Innoue [sic] fails to disclose the following limitations: a first rib formed on the switch board holding member so as to receive a force generated by an operation of the push button switch and that the first rib is in contact with the parts holding member and the first rib is formed with the parts holding member.” Having said this, the Examiner engages in speculation that similar structure can be conjured from Voll and Tickle. As to claims 12 and 13, the Examiner makes much the same assertions with respect to Inoue et al. and Voll as in his earlier rejections, noting as to claim 12 that “Inoue does not provide battery terminal holder portions formed on both left and right sides of the table portion and surrounded by said rib, battery terminals projecting via holes in the parts holder and contacting power supply circuit patterns of the main board, whereby the parts holder receives external force applied during batter replacement insulating the main board from mechanical stress” and as to claim 13 that “Inoue fails to disclose that the parts holder is positioned by inserting pins into pin holes in the main board, the pin holes being provided in both ends of the bottom surface of the parts holder, and the parts holder is fixed to the main board by engaging hooks, which are provided to a rear edge of the bottom surface, with square holes formed in the main board.” In his Response to Arguments, the Examiner “argues that the arrangement of said switch board and the main board are irrelevant provided that the parts holding member separates

the two. . .” The Examiner’s reasoning is in error as he is dismissing the very structure that eliminates the possibility of damage to the printed circuit board due to the replacement of batteries and operation of push switches which is the crux of the invention.

The standard for patentability under 35 U.S.C. §103 was set out by the Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966). The Examiner has failed to make out a *prima facie* case of obviousness under the *Graham* case. Rather, he has engaged in impermissible reconstruction of the references.

Conclusion

The Examiner’s rejections under 35 U.S.C. §103 are in error. The references of record do not make obvious the claimed invention under the standards of patentability enunciated by the courts. In view of the above, it is requested that the position of the Examiner be reviewed, that the rejections be withdrawn, and that the application be passed to issue.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "C. Lamont Whitham", written in a cursive style.

C. Lamont Whitham
Reg. No. 22,424

Whitham, Curtis, Christofferson & Cook, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190

Tel. (703) 787-9400
Fax. (703) 787-7557

Customer No.: 30743